



UNITED STATES PATENT AND TRADEMARK OFFICE

MN

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,696	12/19/2000	Robert Callaghan	00 P 7532 US 01	9143
7590 04/19/2007				
Siemens Corporation				
Attn: Elsa Keller, Legal Administrator				
Intellectual Property Department				
186 Wood Avenue South				
Iselin, NJ 08830				
		EXAMINER		
		PATEL, HARESH N		
		ART UNIT		
		2154		
		PAPER NUMBER		
		MAIL DATE		
		04/19/2007		
		DELIVERY MODE		
		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/742,696

Applicant(s)

CALLAGHAN ET AL.

Examiner

Haresh Patel

Art Unit

2154

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 April 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: None.
Claim(s) objected to: None.
Claim(s) rejected: 1-20.
Claim(s) withdrawn from consideration: None.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

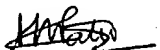
11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____

Continuation of 3. NOTE: the cited prior arts of the final office action dated 2/8/2007 still render the claims unpatentable and the final rejection is deemed proper. Also, the specification of this application under prosecution at lines 2-5 of page 11 clearly states, "The invention described in the above detailed description is not intended to be limited to the specific form set forth herein, but is intended to cover such alternatives, modifications and equivalents as can reasonably be included within the spirit and scope of the appended claims. Since, applicant's claims contain broadly claimed subject matter, it clearly reads upon the examiner's interpretation of the claimed subject matter. Therefore, the rejection is maintained.

Applicant proposed amending the rejected claimed subject matter, with additional limitations, for example, "interfacing a packet network to a private branch exchange (PBX) in an existing private network of a plurality of couple telephony devices", add features to "said" telephony devices, etc., which require further consideration and/or search.

Regarding the applicant's concern that if one already has PBX features in a packet based system, why would one be inclined to add a PBX?, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The First inquiry must be into exactly what the claims define. See *In re Wilder*, 166 USPQ 545, 548 (CCPA 1970). Please see the claims that do not require that the PBX needs to be added. The claimed subject matter is rejected based on what the claim accomplishes. Schuster et al., is the primary reference used in the final office action dated 2/8/2007 that discloses the broadly claimed subject matter of the presented claims. Further, one of ordinary skilled in the art at the time of invention very well knows the usage of PBX and which the reference discloses. The applicant's concern that adding a PBX to the Schuster et al. virtual PBX is in conflict with the above stated Schuster et al. object, is not what the claimed subject matter reflect. In fact, what is claimed is broad and do not require adding the PBX, and the claimed subject matter as presented is not novel and which the Schuster et al. discloses as presented in the final office action. The final office action also contained that when reviewing a reference the applicants should remember that not only the specific teachings of a reference but also reasonable inferences which the artisan would have logically drawn therefrom may be properly evaluated in formulating a rejection. In *re Preda*, 401 F. 2d 825, 159 USPQ 342 (CCPA 1968) and *In re Shepard*, 319 F. 2d 194, 138 USPQ 148 (CCPA 1963). Skill in the art is presumed. In *re Sovish*, 769 F. 2d 738, 226 USPQ 771 (Fed. Cir. 1985). Furthermore, artisans must be presumed to know something about the art apart from what the references disclose. In *re Jacoby*, 309 F. 2d 513, 135 USPQ 317 (CCPA 1962). The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference. In *re Bozek*, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969). Every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. In *re Bode*, 550 F. 2d 656, 193 USPQ 12 (CCPA 1977). Regarding the applicant's usage of "wherein" and/or "whereby" and/or "adapted to" and/or "adapted for" in the claimed subject matter of the claims, the claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. Please see *Minton v. Nat'l Ass'n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)), MPEP 2111. As, the specification of this application under prosecution at lines 2-5 of page 11 clearly states, "The invention described in the above detailed description is not intended to be limited to the specific form set forth herein, but is intended to cover such alternatives, modifications and equivalents as can reasonably be included within the spirit and scope of the appended claims, the applicant's claims contain broadly claimed subject matter, it clearly reads upon the examiner's interpretation of the claimed subject matter. Therefore, the rejection is maintained.

Regarding the applicant's concern why one would ignore the fact that with a Schuster et al. virtual PBX, there is no motivation to add a PBX and one would not be inclined to add a PBX to a Schuster et al. system, and it is the hindsight rather motivation to add the PBX, again although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The First inquiry must be into exactly what the claims define. See *In re Wilder*, 166 USPQ 545, 548 (CCPA 1970). Please see the claims that do not require that the PBX needs to be added. The claimed subject matter is rejected based on what the claim accomplishes. Schuster et al., is the primary reference used in the final office action dated 2/8/2007 that discloses the broadly claimed subject matter of the presented claims. Further, one of ordinary skilled in the art at the time of invention very well knows the usage of PBX and which the reference discloses. The applicant's concern that there is no motivation to add a PBX and one would not be inclined to add a PBX to a Schuster et al. system, and it is the hindsight rather motivation to add the PBX, is not presented in the final office action dated 2/8/2007. In fact, what is claimed is broad and do not require adding the PBX, and the claimed subject matter as presented is not novel and which the Schuster et al. discloses as presented in the final office action. As, the specification of this application under prosecution at lines 2-5 of page 11 clearly states, "The invention described in the above detailed description is not intended to be limited to the specific form set forth herein, but is intended to cover such alternatives, modifications and equivalents as can reasonably be included within the spirit and scope of the appended claims, the applicant's claims contain broadly claimed subject matter, it clearly reads upon the examiner's interpretation of the claimed subject matter. Therefore, the rejection is maintained.



Harresh Patel

4/13/07